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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Richard B. Gorelick et al.

Title: AUTOMATICALLY INSERTING RELEVANT HYPERLINKS INTO A WEBPAGE

Docket No.:	2043.063US1	Serial No.:	09/734,045
Filed:	December 12, 2000	Due Date:	April 27, 2006
Examiner:	Nathan Hillery	Group Art Unit:	2176

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

We are transmitting herewith the following attached items (as indicated with an "X"):

X   Appeal Brief Under 37 C.F.R. § 41.37 (17 pgs.).

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Peter Rebuffoni
Name

_____
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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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In re Application of: Richard B. Gorelick et al.

Examiner: Nathan Hillery

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APPEAL BRIEF UNDER 37 CFR § 41.37

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Appeal Brief is presented in support of the Notice of Appeal to the Board of

Patent Appeals and Interferences, filed on February 27, 2006, from the Final Rejection of

claims 1-4, 7 and 9 of the above-identified application, as set forth in the Final Office

Action mailed on December 27, 2005 and the Advisory Action mailed March 15, 2006.

The Commissioner of Patents and Trademarks is hereby authorized to charge

Deposit Account No. 19-0743 in the amount of 500.00 which represents the requisite fee

set forth in 37 C.F.R. § 41.2(b)(2). The Appellants respectfully request consideration and

reversal of the Examiner's rejections of pending claims.

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1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, HALF.COM, INC. by virtue of the following:

an assignment from inventors Richard B. Gorelick, Steven G. Madere, Michael D. McCartney, Mathew W. Mengerink and David J. Wilson to Deja.com, Inc. recorded January 18, 2001 at Reel 011452, Frame 0155; and

an assignment from Deja.com, Inc. to the present assignee, HALF.COM, INC. recorded December 13, 2001 at Reel 012368, Frame 0273.

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2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants that will have a bearing on the Board's decision in the present appeal.

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3. STATUS OF THE CLAIMS

The present application was filed on December 12, 2000 with claims 1-9. Claims 6 and 8 were canceled in the response to non-final Office Action filed May 28, 2004. Claim 5 was canceled in the response to non-final Office Action filed October 11, 2005. A Final Office Action (hereinafter "the Final Office Action") was mailed December 27, 2005. Claims 1-4, 7 and 9 stand twice rejected, remain pending, and are the subject of the present Appeal.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the Final Office Action dated December 27, 2005.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Some aspects of the present inventive subject matter include, but are not limited to, a method for automatically inserting hyperlinks into a webpage containing text. For example, in one embodiment the method may compare text from a webpage to one or more character strings that may be contained in a database (Figure 4, step 220; Page 16, lines 22-25). The method may perform the comparison to identify character strings in the database that may appear in the text (e.g., Page 19, lines 3-7). Further, each of the character strings may be associated to a hyperlink that may also be contained in the database (Page 18, line 24 – Page 19, line 2), according to one embodiment. The method may insert the associated hyperlink into the webpage (Figure 4, step 230; Page 21, lines 8-9) for each of the identified character strings, according to one embodiment. In addition, the method may designate a name for a product (e.g., "shortname") from multiple names of the product that may be used by a producer of the text (Page 19, lines 8-14), store the name of the product as one of the character strings in the database (Id.), and coordinate with the producers of the text (Page 19, line 21– 23) so that the producers of the text consistently use the name (e.g., "shortname") for the product (Id.) Page 20, line 10), according to one embodiment. By using only the "shortname" to identify the product discussed in the text, the number of strings in the database may be reduced (Page 20, line 3-7). Further by reducing the number of strings, the computations and the time required for step 220 may be reduced (Page 20, line 8-10).

This summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellant refers to the appended claims and its legal equivalents for a complete statement of the invention.

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6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-4, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodkin et al. (U.S. Patent No. 6,092,074 A; hereinafter Rodkin) and in further view of Sundaresan (U.S. Patent No. 6,651,058 B1; hereinafter Sundaresan).

7. ARGUMENT

A) *The Applicable Law under 35 U.S.C. §103(a)*

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title if the differences between the subject matter sought to be patented and between the subject mater sought to be patented and the prior art are such that the **subject matter as a whole** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject mater pertains. Patentability shall not be negatived by the manner in which the invention was made" (emphasis added).

35 U.S.C. §103(a).

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the **claimed invention as a whole** would have been obvious (emphasis added).

MPEP 2141 citing *Stratoflex, Inc. v. Aeroquip Corp.,* 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.,* 713 F.2d 782, 218 USPQ 6908 (Fed. Cir. 1983).

"To establish a *prima facie* case of *obviousness*, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure" (emphasis added).

In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

"All words in a claim must be considered in judging the patentability of that claim against the prior art."

MPEP 2143.03 citing *In re Wilson,* 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

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B) *The rejection of claims 1-4, 7 and 9 was erroneous because the references relied upon in the Final Office Action do not teach or suggest every element of the claims at issue*

Claim 1 includes the following limitation:

communicating the name of the product to a producer of the text, wherein the name of the product is designated from a plurality of names of the product that are utilized by the producer of the text.

The Final Office Action highlights the following disclosure in Sundaresan:

FIG. 5 illustrates an exemplary system 140 for the automatic mining of new relationships... New terms are obtained from relations discovered by the system for automatic mining of patterns and relations of the same kind by selecting an item (or a column) of a pair. For example, for the purpose of identifying relevant products, one can obtain all the product names from the product item (or column) of (company, product) pairs of a production relationship.

Col. 8, lines 22-34.

The above quote from Sundaresan describes a system that mines relations of the same kind to identify terms that are relevant to a given target topic (Col. 4, lines 34-36; Col. 4, lines 27-28; ABSTRACT, TITLE). For example, relations of the same kind may include production relationships and the terms may include product names. Each production relationship may include a company and a product name (e.g., company one - product name one, company two - product name two, etc.). For the purpose of identifying products that are relevant to a target topic the product names (e.g., right column) may be obtained from pairs of production relationships (e.g., (company A, product name A), (company B, product name B), etc).

Claim 1 requires communicating the name of the product to a producer of the text, the name of the product designated from a plurality of names of the product that are utilized by the producer of the text.

In contrast, the above quote from Sundaresan differs from the requirements of claim 1 in a number of respects. First, the above quote from Sundaresan does not describe the ***communication of a product name to a producer of the text***; but rather, mining production relationships to identify product names. Applicants have been unable to find a teaching or suggestion in Sundaresan of a system that communicates a product name to a producer of the text. The Advisory Action responds to this observation by alleging that a system that identifies a term or name would definitely want to communicate the name for further use (Advisory Action, Page 3). Applicant respectfully disagrees. For example, Sundaresan describes a system that obtains a new term from a product relationship and does not communicate the new term to a producer of the text.

Second, the above quote from Sundaresan cannot be said to describe a producer of text. Indeed, Applicants have been unable to find a teaching or suggestion in Sundaresan of the producers of text. For example, the above described production relationships were mined from web pages or documents that may have been downloaded from web sites (Col. 6, line 14-125) on the network (Col. 7, lines 4-16).

Third, the above quote from Sundaresan does not describe the ***designation of a name of a product from a plurality of names of the same product***; rather, the above quote from Sundaresan describes product names that are determined to be relevant to a given target object. Moreover, the above quote from Sundaresan may be said to describe different products because the production relationships describe ***different*** producing companies. The Advisory Action responds to this observation by alleging that "new terms are obtained from relations discovered by the system for automatic mining of patterns and relations of the same kind" is synonymous with "the designation of a name of a product from a plurality of names of the product" (Advisory Action, Page 3). Applicant respectfully disagrees for the above stated reasons.

Sundaresan therefore cannot be said to teach or suggest the above quoted limitation because Sundaresan describes a system that mines relations of the same kind to identify terms that are relevant to a target topic and claim 1 requires communicating the name of the product to a producer of the text, the name of the product designated from multiple names of the product that are used by the producer of the text.

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The above remarks are also applicable to a consideration of independent claim 9.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 2-4 and 7 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, Rodkin in combination with Sundaresan does not teach or suggest each and every limitation of claims 1, and 9 as required to support rejections of the independent claims of the present application under 35 U.S.C.§ 103.

C) *The rejection of claims 1-4, 7 and 9 was erroneous because Final Office Action does not determine whether the claimed invention as a whole would have been obvious*

As noted above, the Final Office Action and the Advisory Action have alleged that a number of differences between the prior art and the limitations of independent claim 1 would have been obvious. However, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences *themselves* would have been obvious, but whether the claimed invention *as a whole* would have been obvious (35 U.S.C. 103).

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8. SUMMARY

For the reasons argued above, claim 1 was not properly rejected under § 103(a) as being unpatentable over Rodkin in combination with Sundaresan.

It is respectfully submitted that the art cited does not render the claims obvious and that the claims are patentable over the cited art. Reversal of the rejection and allowance of the pending claim are respectfully requested.

Respectfully submitted,

RICHARD B. GORELICK et al.

By their Representatives,

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Date ___4.27.2006___ By _____

Mark R. Vatuone
Reg. No. 53,719

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___Peter Rob,ffon_____
Name

_____
Signature

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CLAIMS APPENDIX

1.   (Rejected) A method for automatically inserting hyperlinks into a webpage containing text, the method comprising:

comparing the text to at least one character string contained in a database to identify specific character strings from the database that appear in the text, wherein each of the character strings has an associated hyperlink that is also contained in the database;

for each of the identified character strings contained in the text, inserting the associated hyperlink into the webpage;

designating a name for a product;

storing the name of the product as one of the character strings in the database; and

communicating the name of the product to a producer of the text, wherein the name of the product is designated from a plurality of names of the product that are utilized by the producer of the text.

2.   (Rejected) The method of claim 1 wherein the text comprises content of a newsgroup article.

3.   (Rejected) The method of claim 1 wherein the hyperlinks are inserted into the text of the webpage.

4.   (Rejected) The method of claim 3 wherein inserting the associated hyperlink further comprises reconfiguring computer code used to form the webpage such that the identified character strings change appearance, and the associated hyperlink is selectable by a user that selects and clicks the identified character strings.

7.   (Rejected) The method of claim 1 wherein only the first occurrence in the text of the character string is hyperlinked.

9.   (Rejected) A system for automatically inserting relevant hyperlinks into text contained in a file, the system comprising:

a first means to receive the text;

a second means to determine if a character string that is stored in a database appears in the text, wherein the database further contains a hyperlink that is associated with the character string;

a third means for inserting the hyperlink into the text if the character string appears in the text.; and

a fourth means for designating a name for a product, storing the name of the product as one of the character strings in the database, and communicating the name of the product to a producer of the text, wherein the name of the product is designated from a plurality of names of the product that are utilized by the producer of the text.

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EVIDENCE APPENDIX

None.

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<u>RELATED PROCEEDINGS APPENDIX</u>

None.